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09/036,458 03/06/98 ANGELOPOULOS

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ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No. <u>29/036,458</u>	Applicant(s) <u>Angelopoulos et al</u>
Examiner <u>T. Yorn</u>	Group Art Unit <u>1714</u>

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 9-27-89
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-2 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-2 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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In the middle of the table 1, 50150, 75125 and 63137 should be 50/50, 75/25 and 63/37, respectively. The recited "lowe" in line 15, page 11 should be "low".

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The "substituted" claim 3 is not commensurate in scope with an enabling disclosure until the named groups for "substituted", as described in the instant specification, are recited in the claims for "substituted". If there are no examples for "substituted", in the instant specification, "substituted" must be cancelled because the specification is not enabling for the skilled artisan to practice the invention. It would require undue experimentation to determine all of the groups which are encompassed by and how to attach these groups to the claimed compound. This is a current Group practice, and what is allowed in other patents is immaterial in this application.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1, 7, 12, 15, 16, 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 2, "and a n" should be "and an", and line 3, "--- solvent said polymer in said solvent characterized ---" does not make sense. In claim 7, lines 3 and 4, "--- polymer said polymer in said solvent ----" does not make sense.

In claim 12, improper Markush language is recited, and a proper format is "----- selected from the group consisting of A, B, C, ---- and Z". There are two phrases (of selected from the group consisting of) at line 2 and the second and third line of the amended page 6. Also, there are numerous improper recitations in the claim, and careful review and corrections are required.

The examiner points out some improper recitations for example;

1. "or" in lines 12, 15 and 17, for example, needs to be deleted.
2. "such" in line 16, for example, needs to be deleted.
3. "and such" in lines 18-20, for example, needs to be deleted.
4. Trademark (Florinato FC-40, FC-75, line 31) is not permitted in the claim, and cancellation of Trademarks and Company name in lines 27-28 is required.
5. "such as" in line 35, for example, needs to be deleted.
6. "foluorine-substituted esters" in line 38 should be "fluorine-substituted esters".
7. The recited "derivative" in line 48 is indefinite, and not permitted in the claim. What is "organic-phosphorus compound-arsenic compound-fluorine derivatives" in lines 47-48?

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8. Claim must have one period (.) at the end. However, line 59 also contains the period. Also, in said line, "Preferred solvents includes---" is indefinite.
9. The recited formula  $C_8F_{17}SO_2$ ---- in the third line from bottom should be " $C_8F_{17}SO_2$ ----".
10. "and" (other than the last one), such as, etc., e.g. in other lines needs to be deleted.

In claim 15, the structure is confusing since there are two negative charges near "N" and the first nitrogen contains double negative charges instead of two radicals in the left bracket and since there is no "A" in the right bracket (negative charge is located between A and N).

In claim 16, line 5, the recited " $Q^+$ " lacks an antecedent basis in the formula.

In claim 20, line 3, "hexafluorophenylpropaol" should be "hexafluorophenylpropanol", and line 4, "depont" should be "dopant". Line 5, "camphorulfonic" and "sulforic" should be "camphosulfonic" and "sulfuric", and claim contains two periods.

In claim 21, improper Markush language is recited, and line 3, "and so on such as anisole, ---" is improper also.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 8, 9-12, 17-19 and 21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jonas et al (US 4,902,573).

Jonas teaches the instant invention at col. 5, lines 16-41 wherein the use of fluorinated hydrocarbons and a mixture of thereof are taught.

Rejection is maintained for reason of record, and following.

As pointed out by applicant, the instant claims do not requires the polymerization of monomers in the presence of a fluorinated solvents, and the processing of a conductive polymer having any intrinsic conductivity in a fluorinated solvents meets the invention. Note that the instant claims do not require changing the conductivity of a polymer and thus the reference showing at least one conductivity meets the invention.

Claims 1-4, 9-12, 17 and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Traynor (US 4,629,798).

Rejection is maintained for reason of record and of above.

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Claims 1-4, 6, 7, 9-12 and 16-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ikenaga et al (US 4,772,421).

Rejection is maintained for reason of record and of above.

In example 6 of Ikenaga clearly teaches the polymerization of pyrrole in a mixture of fluorinated solvents, for example, as pointed out by the examiner in the last Office Action.

Claims 1-4, 9-15 and 17-19 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tan (US 5,863,658).

Rejection is maintained for reason of record and of above.

Claims 1-4, 6, 7 and 9-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0315514.

Rejection is maintained for reason of record and of above.

Applicant has requested a telephone interview if the case is not allowed by citing MPEP 713.01, however, it does not appear that the interview would result in expediting the case to a final rejection as evidenced by the above rejections. Also, said section of MPEP states that it is desirable that the attorney indicate in advance what issues he desires to discuss at the interview. But, applicant failed to do so. Thus, no interview is granted.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Mon-Thr from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for this Group is (703) 305-5433.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

THY/August 26, 1999



**TAE YOON  
PRIMARY EXAMINER**